

**IN THE CLAIMS:**

Please amend the following claims:

Claim 1, line 4                      change "comprising" to -- consisting essentially of--

Claim 20, line 3                      change "claim 12" to -- claim 22--

**REMARKS**

The Official of January 3, 2000 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 1 has been amended to recite that the claimed cationic, water-soluble resin defined by formula I is essentially the only cationic, water-soluble resin present in the claimed ink composition. Support for this recitation appears, by way of example, in the working examples of the specification wherein the claimed resin of formula I alone is used as the cationic, water-soluble resin. Further support for the amendment to claim 1 appears, by way of example, in the specification at page 5, lines 28 - 31 wherein it is described that the claimed ink composition "may further comprise" another water-soluble resin. The specification thus shows that, as of the application filing date, Applicants contemplated both an ink composition wherein there are other water-soluble resins present and an ink composition wherein the recited cationic, water-soluble resin is the only water-soluble resin present.

The Examiner has maintained the rejections under 35 USC 103(a) on the basis of the art cited at paragraphs 6 - 8 of the Official Action. Applicants respectfully traverse these rejections.

By virtue of the amendments to claim 1 discussed above, the Applicants have essentially excluded from the claimed ink composition the presence of cationic, water-soluble resins other than that of the recited formula I. All of the inks in the Examples in the present specification contain (only) the resin of formula I as the cationic, water-soluble resin. As discussed in Applicants' Amendment dated October 25, 1999, the Examples and Comparative Examples of the specification prove the advantageous results of an ink composition as claimed that includes the recited cationic, water-soluble resin.

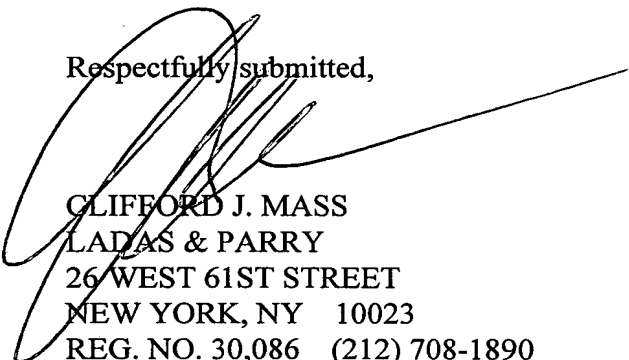
Of the references cited by the Examiner, only the Tomita et al reference shows the claimed cationic, water-soluble resin. However, Tomita et al does not disclose the use of the resin of the recited formula I alone. To the contrary, Tomita et al teach that the resin of formula I, if present in an ink composition, should be present in a mixture with other cationic, water-soluble resins. Indeed, as discussed in Applicants' Amendment dated October 25, 1999, the preferred compositions exemplified in Tomita et al use only polyethyleneimines rather than the resins of formula I. Accordingly, it is respectfully submitted that Tomita et al actually teaches away from the invention as now claimed. *A fortiori* Tomita et al do not show or suggest that the use of the resin of formula I alone is advantageous as compared with the use of polyethyleneimines which are disclosed in Tomita et al as working examples.

In view of the above, it is respectfully submitted that the cited references are not properly

combinable to arrive at the claimed invention. In particular, it is respectfully submitted that it is only through hindsight, with the aid of the present disclosure, that one of skill in the art would select the resin of formula I from Tomita et al for use as the only cationic, water-soluble resin in the claimed ink composition.

In view of the above, it is respectfully submitted that all rejections and objections of record have been successfully traversed and that the application is now in allowable form. An early Notice of Allowability is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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